



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 67

FISH & RICHARDSON P.C.
1425 K STREET, N.W.
11TH FLOOR
WASHINGTON DC 20005-3500

COPY MAILED

APR 04 2003

OFFICE OF PETITIONS

In re Application of :
Christopher J. Wright, Jonathan K. Robertson, :
Patrick Hufford, Terry Rolon, and Thomas :
Stehnach :
Application No. 09/666,104 : DECISION ON PETITION
Filed: November 30, 2000 :
Attorney Docket No. SP00-338 :
Title: DYNAMIC GAIN SLOPE :
COMPENSATOR :

This is in response to the petition under 37 C.F.R. §1.47(a)¹ and 37 C.F.R. §1.48(a)², filed concurrently on August 8, 2001.

On September 20, 2000, the application was deposited, identifying Joseph G. Barrett, Christopher J. Wright, and Jonathan K. Robertson as joint inventors.

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that the non-signing inventor refuses to join in the application or cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

² A grantable petition under 37 C.F.R. §1.48(a) requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by §1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

With the instant petition, the petitioner has included the filing fees for both petitions, has requested that the inventive entities be amended to delete inventor Barrett and to add inventors Hufford, Rolon, and Stehnach, and has included:

1. statements from inventors Barrett, Stehnach, and Hufford
2. a declaration executed by inventors Wright, Robertson, Hufford, and Stehnach (i.e. the applicant considers Rolon to be a non-signing inventor);
3. an unsigned statement from non-signing inventor Rolon;
4. a statement from the Senior V.P. and General Counsel of AOL, the purported assignee
5. a statement from Mr. Renner, the attorney of record
6. a copy of a letter sent from Mr. Renner, an attorney of record, to the non-signing inventor, dated February 28, 2001, accompanied by the matching Federal Express label, and a print-out of the Federal Express tracking results,
7. a copy of a letter sent from AOL to Mr. Key, an attorney of record, dated April 27, 2001, accompanied by the matching Federal Express label;
8. a copy of a letter sent from Mr. Renner, an attorney of record, to the non-signing inventor, dated May 21, 2001, accompanied by the matching Federal Express label, and a print-out of the Federal Express tracking results,
9. a copy of a letter sent from Mr. Renner, an attorney of record, to the non-signing inventor, dated June 25, 2001, accompanied by the matching return receipt, and;
10. a duplicate copy of the April 27, 2001 letter from AOL to Mr. Key;

Regarding the petition under 37 C.F.R. §1.47(a), the petitioner has met requirements (1) - (3), and (5) of 37 C.F.R. §1.47(a) above.

Regarding the fourth requirement above, petitioner states that the non-signing inventor "cannot be reached after diligent effort" (emphasis included)³. Petitioner mailed three letters to the non-signing inventor, and received confirmation that the first two letters were delivered to the last known address. A postcard receipt was included with the third letter, and came back bearing the signature of someone other than the non-signing inventor. Petitioner then determined that he was unable to reach the non-signing inventor, and filed the present petition. Although it was concluded that the non-signing inventor could not be reached, there is no indication that Rule 47 applicant made any attempt to verify inventor Rolon's address or to determine his forwarding address, and to send the application papers to that address for consideration by inventor Rolon⁴. Contrary to petitioner's assertion, the failure to make even the slightest attempt at securing the proper address cannot be characterized as a diligent effort in attempting to reach the non-signing inventor.

Petitioner should make a good-faith attempt at locating the non-signing inventor prior to submitting any renewed petition. If attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet continue to fail, then applicant will have provided the necessary proof required under 37 C.F.R. §1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should

³ Petition, page 1.

⁴ See MPEP 409.03(d).

be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicant should submit documentary evidence such as the results of an E-mail or Internet search.

Consequently, the petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Regarding the petition under 37 C.F.R. §1.48, the petitioner has met requirements (1) and (4) – (5) above.

Regarding the second and third requirement above, the non-signing inventor has signed neither a statement indicating that the omission occurred without deceptive intent on his part nor the oath or declaration.

If petitioner continues to be unable to obtain these requirements from inventor Rolon, he may wish to consider filing a petition under 37 C.F.R. §1.183 requesting a waiver of these requirements. Petitioner must show that these items were presented to the non-signing inventor, and he refused to sign⁵.

Consequently, the petition under 37 C.F.R. §1.48(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a) (and/or) 37 CFR 1.47(b)."

The reply to this letter may be submitted by mail⁶, hand-delivery⁷, or facsimile⁸.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries pertaining to *this decision* should be directed to Attorney Paul Shanoski at (703) 305-0011.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

5 The petition under 37 C.F.R. §1.47(a) addresses the mailing of the declaration to non-signing inventor Rolon, but it is not clear if the statement of deceptive intent was mailed to him as well.

6 Commissioner for Patents, Box DAC, Washington, DC 20231.

7 Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

8 (703) 308-6916, Attn: Office of Petitions.